



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/778,635	02/07/2001	Thomas J. Colson	822.000418	9591
24041	7590	02/17/2005	EXAMINER	
SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406			COLON, CATHERINE M	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 02/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

JG

Office Action Summary

<i>AV</i>	Application No.	Applicant(s)
	09/778,635	COLSON ET AL.
	Examiner	Art Unit
	C. Michelle Colon	3623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 01 December 2004.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-4,6-14 and 16-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-4,6-14 and 16-30 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

1. The following is a Final Office Action in response to the communication received on December 1, 2004. Claims 1, 11, 21 and 26 have been amended. Claims 5 and 15 have been cancelled. Claims 1-4, 6-14 and 16-30 are now pending in this application.

Response to Arguments

2. Applicant's arguments have been fully considered, but are found unpersuasive.

In the Remarks, Applicant argues that BountyQuest does not teach removing information related to publication of substantive information.

In response to the argument, Examiner respectfully disagrees. In particular, and as admitted by Applicant on page 7 of the Remarks, BountyQuest discloses on page 10 that a bounty hunter's name is kept anonymous before their submission is sent to a bounty poster. Thus, while BountyQuest is aware of the bounty hunter's identity, the name is removed, or "sanitized," from the substantive information submitted by the bounty hunter before being published, or provided, to the bounty poster. The limitation, "removing information related to publication of substantive information," does not expressly recite what information is being sanitized, just that the information is *related to* publication of the substantive information. On page 7 of the Specification, Applicant provides specific examples of information that can be "sanitized;" however, none of the specific examples are recited in the claims. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The limitation also

does not expressly recite who is performing the sanitizing. Thus, the bounty hunter merely omitting information submitted via the online form (page 16 of BountyQuest) can be construed as sanitizing information. Accordingly, Examiner respectfully submits that applying the broadest reasonable interpretation to the limitation, BountyQuest does disclose removing information related to publication of substantive information through its teaching of removing a bounty hunter's name before providing the submission to the bounty poster.

In conclusion, Applicant's arguments have been fully considered, but are found unpersuasive. The rejections of claims 1-4, 6-14 and 16-30 are provided below.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

4. Claims 1-4, 6-14 and 16-30 are rejected under 35 U.S.C. 102(a) as being anticipated by BountyQuest as disclosed on Web Archive (November 9, 2000).

As per claim 1, BountyQuest discloses a method for collecting and communicating information related to validity of a patent over a global information network, comprising:

a) soliciting bounty hunters via a global information network for prior art related to validity of said patent (pages 1-5, 10 and 14; BountyQuest solicits bounty hunters for

prior art by placing bounty posting on its website. See sample posting from October 18, 2000.);

b) receiving substantive information related to said validity of said patent from at least one of said bounty hunters in response to said solicitation (pages 15 and 16; Bounty hunters submit relevant information related to a bounty posting.); and,

c) sanitizing said substantive information to remove information related to publication of said substantive information (page 17; When BountyQuest receives submissions of substantive information from bounty hunters, BountyQuest removes, or sanitizes the name of the bounty hunter from the substantive information before publishing, or providing, the information to the bounty poster.).

As per claim 2, BountyQuest discloses the method of Claim 1 further comprising the step of submitting said sanitized substantive information to a bounty offeror (page 17; When BountyQuest receives information, it filters the data and keeps bounty hunters anonymous. The information is forwarded to the bounty offeror.).

As per claim 3, BountyQuest discloses the method of Claim 2 further comprising the step of paying a bounty to one of said bounty hunters a bounty when said received substantive information meets specific requirements (pages 13, 16 and 17; A bounty hunter is paid a bounty if the information meets certain requirements.).

As per claim 4, BountyQuest discloses the method of Claim 2 wherein said specific requirements are specified by said bounty offeror (pages 3-5 and 12-15; The requirements for the bounty hunter are specified by the poster. See sample posting from October 18, 2000.).

As per claim 6, BountyQuest discloses the method of Claim 1 wherein said sanitizing comprises removal of information related to identity of the third party who submitted said substantive information (page 17; Bounty hunters' names are kept anonymous when their submissions are reviewed and possibly made public.).

As per claim 7, BountyQuest discloses the method of Claim 1 further comprising the step of time-stamping submissions of bounty hunters in response to said solicitation to determine chronological order of receipt (pages 16 and 17; An "official" time of submission is established for each entry.).

As per claim 8, BountyQuest discloses the method of Claim 1 further comprising the step of comparing at least two submissions of substantive information received in response to said solicitation to determine if substantive information received from one of said bounty hunters differs from substantive information received from another of said bounty hunters (pages 13, 16 and 17; If multiple submissions are received, they are compared for the time they are received and for the substance of the information.).

As per claim 9, BountyQuest discloses the method of Claim 8 further comprising the step of submitting a plurality of sanitized substantive information disclosures to a bounty offeror when said comparison indicates that different substantive information has been received from at least two of said bounty hunters (pages 13, 16 and 17; When multiple submissions are received from different bounty hunters, the submissions are compared for the time they are received and for the substance of the information. If the bounty poster is already aware of a reference submitted, additional submissions are allowed to determine a winner.).

As per claim BountyQuest discloses 10, the method of Claim 9 further comprising the step of paying a bounty to at least one of said bounty hunters when certain requirements are met (pages 13, 16 and 17; A bounty hunter is paid a bounty if the information meets certain requirements.).

Claims 11-14 and 16-30 recite substantially similar limitations to claims 1-4 and 6-10 above. Therefore, claims 11-14 and 16-30 are rejected on the same basis as claims 1-4 and 6-10 above.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Henrickson, Dyke. "Quest for invalidation," *Mass High Tech, The Journal of New England Technology*, November 6, 2000 [retrieved from Internet on www.archive.org] discusses BountyQuest.com.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Michelle Colon whose telephone number is 703-605-4251. The examiner can normally be reached Monday – Friday from 8:30am to 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz, can be reached at 703-305-9643.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington D.C. 20231

or faxed to:

703-872-9306 [Official Communications; including After Final
communications labeled "Box AF"]

Application/Control Number: 09/778,635
Art Unit: 3623

Page 8

703-746-7202 [For status inquiries, draft communication, labeled
"Proposed" or "Draft"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA 7th floor receptionist.

OMC
emc

February 7, 2005

Susanna Diaz
SUSANNA M. DIAZ
PRIMARY EXAMINER

AU 3623